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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/939,905

09/29/1997

MARK GIJZEN

GRT/76-105

4378

23117 7590 05/30/2007

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EXAMINER

ZHOU, SHUBO

ART UNIT

PAPER NUMBER

1631

MAIL DATE

DELIVERY MODE

05/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

08/939,905

Applicant(s)

GIJZEN, MARK

Examiner

Shubo (Joe) Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7-9, 11, 12, 14-29, 36-39 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 7-9, 11-12, 14-29, 36-39, and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's amendments and request for reconsideration filed 3/6/07 are acknowledged and amendments entered.

Claims 1, 3-4, 7-9, 11-12, 14-29, 36-39, and 41 are currently pending and under consideration.

#### ***Withdrawn Rejections***

The rejection of claims 19 and 21 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter set forth in the previous Office action is hereby withdrawn in view of applicant's amendment to the claims filed 3/6/07.

The rejection of claims 37 and 39 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement (new matter rejection) set forth in the previous Office action is hereby withdrawn in view of applicant's argument. See page 9 of the response filed 3/6/07.

The rejection of claims 19 and 21 under 35 U.S.C. § 102(a) as being anticipated by Gijzen et al. (Plant Physiology, Vol. 103, pages 1061-1066, 1993) set forth in the previous Office action is hereby withdrawn in view of applicant's amendment to the claims filed 3/6/07.

#### ***Specification***

The specification is objected to because of the following including informalities:

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It seems that the word “or” is missing in the specification on page 5, line 6 before the phrase “SEQ ID NO:2.”

Trademark is used in this application, such as HYBOND on page 28. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

In the amendment filed 3/6/07, applicant amended the specification to capitalize the trademark “GENBANK,” but there are still other trademarks such HYBOND on page 28 that are not capitalized. Applicant is requested to review the entire specification to ensure all trademarks are capitalized.

Appropriate correction is required.

### ***Claim Rejections-35 USC § 112***

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 36 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 36 and 38 are amended to contain the limitation of “20 contiguous nucleotides”

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of nucleotides 1524-1610 of SEQ ID NO:2 to be used as labeled sequence for hybridization to select between EpEp and epep plant genotypes. This new limitation is considered new matter because the limitation is not adequately described in the specification.

This rejection is reiterated from the previous Office action. Applicant argue that support for this limitation is disclose on page 28, lines 1-5. However, what is described in the referenced page are primers of 20 nucleotides long for PCR amplifications of genomic DNA or cDNA, but not for hybridization. Furthermore, the primers described on page 28 are not labeled for hybridization as recited in claims 36 and 38.

Claims 7, 16, 18, 20, 22, 24, 26, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7 is drawn to DNA molecule comprising a nucleotide sequence that hybridizes to nucleotides 1-1532 of SEQ ID NO:2 or a complement thereof under certain specific conditions, wherein the nucleotide sequence is a promoter.

Claims 16, 18, 20, 22, 24, 26, 28 and 29 depend from claim 7 directly or indirectly.

The specification describes that 1-1532 of SEQ ID NO:2 has regulatory such as promoter activity. However, the specification does not describe any sequence, such as the complementary sequence of nucleotides of 1-1532 of SEQ ID NO:2, that hybridizes to 1-1532 of SEQ ID NO:2 also have promoter activity.


***Conclusion***

Claims 1, 3-4, 8-9, 11-12, 14-15, 17, 19, 21, 23, 25, 27, 37, 39, and 41 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

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SHUBO (JOE) ZHOU, PH.D.  
PATENT EXAMINER